REMARKS

Initially, in the interest of clarifying the record, Applicants note the Examiner on page 2 of the Office Action, section 2 indicated that "Applicant's election without traverse of Group I (claims 1-12) as set forth in the last Office Action is acknowledged." (Emphasis Added). Applicants orally elected claims 1-12 with traverse and confirmed this traversal in their August 26, 2003 response on page 5. Acknowledgement of the election with traverse is respectfully requested.

Applicants amended claims 1 and 9 in accordance with the specification, considered as a whole, e.g., see page 14, lines 8-11.

Claims 1-3, 5-7 and 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mills et al. (U.S. 5,447,771) in view of Smith et al. (U.S. 3,852,946).

Claims 22-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mills et al. (U.S. 5,447,771) in view of Smith et al. (U.S. 3,852,946) as described for claims 1 and 9, further in view of Abel et al. (U.S. 4,071,468).

35 U.S.C. §103(a)

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-7 and 9-11 stand rejected under 35 U.S.C. §103(a) over Mills et al., U.S. Patent 5,447,771 ("Mills et al." or "Mills") in view of Smith et al., U.S. Patent 3,852,946 ("Smith et al." or "Smith"). The Examiner has acknowledged that Mills et al. fails to teach a yarn having a denier range of 15-200 and cited Smith as having a "total denier ranging from 100 or less to 3,000 or more." Office Action, p. 4. Applicants previously argued that Mills et al. failed to teach a low denier yarn (i.e. having a denier between about 15 and about 200) which is useful in apparel fabrics having a high moisture wicking capability, soft hand and which is silk-like in appearance. The Examiner found the argument unpersuasive because the Applicants are not claiming such an article and that such an "intended use" would not be given patentable weight. Further the Examiner stated that "there is nothing on the record to evidence that the articles produced by Mills et al., having the claimed

structure and chemistry could not function in the desired capacity. Thus, the burden is therefore shifted to Applicant to evidence the contrary." Office Action, p. 3

Initially, Applicants point out the claimed invention is generally directed to a yarn formed at least in part from a filament having a cross-sectional bilobal S-shape or Z-shape, wherein the cross-section for the S- and Z-shaped filament comprises a substantially flat sided rectangular-shaped central segment having two opposite ends with a substantially flat sided arm having a curved tip portion extending from each opposite end of the central segment, wherein the width of the central segment and each arm is substantially the same, and the length of the central segment and each arm is substantially the same, wherein the angle formed between the arms and the central segment ranges from about 105° to about 165°, and wherein the bilobal filaments of the yarn have a denier per filament between about 0.1 to about 4.0, and the yarn has a denier of between about 10 and about 200 or about 15 and about 200.

As stated above, the Examiner acknowledged that Mills et al. do not teach a denier between about 15 and about 200. Therefore, the teaching or a suggestion of a denier between about 15 and about 200 must be found in Smith et al. and there must be a motivation to combine the references. Initially, the Examiner cites Smith et al. as teaching "that the novel yarn, which is excellent as the pile for carpeting, generally have a total denier ranging from 100 or less to 3,000 or more (Column 8, 25-30)." Office Action, p. 4.

As stated by the Federal Circuit, "a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure. *Id* at 493. *See also* M.P.E.P. § 2142. Applicants point out that the fact that a claimed product is within a broad field of the prior art and one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some directions or reasons in the prior art for making such selections. *Ex parte Kuhn*, 132 U.S.P.Q. 359 (Pat. & Tr. Office Bd. App.)(1961).

Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. *In re Semaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983).

Applicants respectfully submit that the combination of Mills and Smith is

improper because there is no suggestion in either reference (nor in any other art of record) of desirability or motivation to combine the references. The combination could be made with the benefit of hindsight provided by Applicants' own teachings, which is impermissible in non-obviousness analysis.

The combination of Mills with Smith, albeit improper, would actually teach away from the Applicants' claimed invention. Initially, Applicants note that the section to which the Examiner cites as "teaching" the now claimed range by Applicants is Column 8, 17-19 which reads in its entirety "...generally the total denier ranges from about 100 or less to 3,000 or more and preferably about 1,000 to 2,000." (Emphasis added). Thus the section to which the Examiner cites as teaching denier lower ranges (which Mills is admitted as failing to teach), actually teaches it is preferred to use denier ranges (i.e. 1000 to 2,000) which are at least 500% higher than the Applicants' approximate upper end of the claimed denier range. This is contrary to Applicants' claimed invention. Further, Smith in Column 1, line 65 through Column 2, line 4 states "It is a particular object of the present invention...for the purpose of steam bulking either a single yarn of low denier into a yarn of higher denier, or a plurality of yarns of low denier, and possibly even yarns having initial opposite twists, into a single composite bulked or voluminous yarn having a high denier, suitable for use as a commercial carpet yarn." Therefore, Smith is directed to providing yarns of higher denier, not lower denier as claimed by Applicants.

The Examiner has done no more than find portions of separate elements of the claimed invention and argue that broad disclosures which would require specific selection and experimentation to achieve the Applicants' claimed invention, render the claimed invention obvious. The Examiner argues that the combination of carpet disclosures which are directed to increased yarn denier may be combined to teach the claimed lower denier yarn. There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Lindemann v. Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). *Interconnect Planning Corporation v. Feil, et al.*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). In the present case there is no such motivation. One cannot pick and choose among individual parts of assorted references as a mosaic to recreate a facsimile of the claimed invention. *AKZO N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986). *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Applicants have shown that the claimed invention would not have been obvious to a person ordinarily skilled in the art in view of the cited references. Thus, there would be no motivation to employ the claimed denier range of about 10 to about 200 in view of the prior art teaching of higher denier. Furthermore, the art also fails to suggest other limitations of

Applicants' claims, such as denier per filament (pdf) between about 0.1 and about 0.4.

For all the reasons discussed above, Applicants' claims are patentable in view of the references of record. As each of the independent claims is non-obvious in view of the cited references, each of the claims which depends therefrom is also non-obvious. The rejection is respectfully traversed.

Applicants also traverse the rejection of claims 22 and 23 in view of Mills, Smith and, further in view of Abel et al., U.S. Patent 4,0711,468. While Abel may disclose various wetting agents, he fails to overcome deficiencies of both Mills and Smith in failing to render obvious claims 1 and 9 as discussed above, and therefore claims 22 and 23, dependent from claims 1 or 9. Furthermore, the combination of Mills, Smith and Abel is erroneous as a matter of law because none of these references contains a suggestion or motivation to make the combination. For at least these reasons, Applicants respectfully traverse the rejection.

In view of the foregoing, Applicants respectfully submit that the above-referenced application is in condition for allowance. Reconsideration and allowance of all pending claims is respectfully requested. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at (302) 999-4342. This Amendment after Final Rejection has been filed within three months of the mailing date of the Office Action, and therefore it is believed that no fees are due upon filing. If any fees are determined to be due, please charge those fees to the undersigned's Deposit Account No. 04-1928.

Respectfully submitted,

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